



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRANSMITTAL LETTER

in re Patent Application entitled:

SELF-BALLASTED SCREW-IN FLUORESCENT LAMP

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Enclosed herewith is a patent application entitled  
SELF-BALLASTED SCREW-IN FLUORESCENT LAMP.

Also enclosed herewith are: an OATH, a Statement Claiming Small Entity Status, a check for the filing fee in the amount of \$187.00 (Check #1209); and a pre-paid self-addressed card for the Commissioner to send back to Applicant to verify receipt of application.

Directly attached hereto is a listing of SELECTED AUTHORITIES AND PARAGRAPHS FROM MPEP. For purposes of more effective prosecution of instant application, Examiner is specifically requested to evaluate the claims in light of the listed authorities as well as in accordance with the selected paragraphs from MPEP.

In particular, in case of a possible rejection under 35 U.S.C. 103, Examiner is requested to respond in full accordance with MPEP paragraph 706.02, and to heed Authorities #5-6 and #9-12. Also, Examiner is requested to take notice of recent decisions by CAFC, especially in respect to the position by that Court relative to the issue of obviousness and the requirement of prior art to plainly indicate whatever might be considered to represent an obvious suggestion of the claimed invention.



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SELECTED AUTHORITIES AND PARAGRAPHS FROM MPEP

Selected Authorities

#1. "Where unobvious aspect of invention resides in recognition of source of problem, Patent Office inquiries should be directed, in part at least, to question of whether such a recognition would have been obvious to one of ordinary skill in the art; inquiry must go beyond the nature of the solution" (In re Roberts, 470 F.2d 1399, 176 USPQ 313 (1973);

#2. "A patentable invention within the ambit of 35 U.S.C 103 may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the result inherent in their use" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243 (1969);

#3. "patentable invention may lie in discovery of source of problem even though remedy may be obvious once source of problem is identified" (In re Sponnoble, 405 F.2d 578, 160 USPQ 237 (1969);

#4. "we also believe that a more proper, albeit not exclusive, inquiry in a case such as this is to look further as to the reasons for making the combination" (In re Sponnoble, 405 F.2d 578, 160 USPQ 243 (1969);

#5. "If there is no evidence that a person of ordinary skill in the art at time of applicant's invention would have expected problem to exist at all, it is not proper to conclude that invention which solves this problem, which is claimed as an improvement of prior art device, would have been obvious to that hypothetical person". (In re Nomiya, 184 USPQ 608, 1975)

#6. "There must be a reason apparent at time invention was made to person of ordinary skill in the art for applying the teaching at hand, or use of teaching as evidence of obviousness will entail prohibited hindsight". (In re Nomiya, 184 USPQ 608, 1975)

#7. Application of Miller (57 CCPA 809, 418 F2d 1392, 164 USPQ 46) affirming the patentability of a "new use of a known process, machine, manufacture, composition of matter, or material".

#8. In re Sung Nam Cho (Appeal No. 86-973 at the PTO) the Board of Appeals concluded that the examiner had misstated the law by "equating that which is within the capabilities of the skilled designer with obviousness".

#9. In Richdel, Inc. v. Sunspool Corp. (714 F.2d 1573 -- Fed Cir. 1983), Chief Judge Markey presented a detailed rejection of the doctrine of combination patents: "It was error for the district court to derogate the likelihood of finding patentable invention in a combination of old elements. No species of invention is more suspect as a matter of law than any other. Attempted categorization for the purpose of determining various "rules" detracts from what should be the sole question: whether the claimed invention would have been obvious within the meaning of paragraph 103. Most, if not all, inventions are combinations and mostly of old elements".

#10. In Adams (356 F.2d 998 -- CCPA 1966), the Board (of Appeals) was reversed because "neither reference contains the slightest suggestion to use what it discloses in combination with what is disclosed in the other." (356 F.2d at 1002)

#11. In Imperato (486 F.2d 585 -- CCPA 1973): although combining the references' teachings yielded the result claimed, the CCPA held that the combination was not obvious "unless the art also contains something to suggest the desirability of the combination".

#12. In Sernaker (702 F.2d at 995-96), the CAFC interpreted Imperato to mean that "prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings".

#13. In Environmental Design (713 F.2d at 698), the CAFC stated: "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant" [to obviousness].

#14. In Fromson v. Advance Offset Plate (755 F.2d 1556), the CACF stated as follows. (Underlining by Applicant)

"Where, as here, nothing of record plainly indicates that it would have been obvious to combine previously separate process steps into one process, it is legal error to conclude that a claim to that process is invalid under paragraph 103."

#15. In Kimberly-Clark Corporation v. Johnson & Johnson (745 F.2d at 1449), the CAFC stated as follows. (Underlining by Applicant)

"examining all the references of record, we fail to find a clear suggestion of the claimed subject matter. ---- The holding of invalidity on the ground of obviousness is therefore reversed."

#16. In Kansas Jack (719 F.2d at 1144), the CAFC stated that "one may not use the teachings of the present invention as a guide to interpretation of the prior art".

Selected Paragraphs from MPEP (Underlining by Applicant)

706.02 Rejection on Prior Art

"After indicating that the rejection is under 35 U.S.C. 103, there should be set forth (1) the difference or differences in the claim over the applied reference(s), (2) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (3) an explanation why such proposed modification would be obvious"

706.07 Final Rejection

"present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his invention in claims that will give him the patent protection to which he is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his case"

"The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal is prosecuted"

"In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal"

"where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's response"

/07.07(f) Answer All Material Traversed

"Where the applicant traverses any rejection, the examiner should, if he repeats the rejection, take note of the applicant's argument and answer the substance of it"

707.07(j) State When Claims Are Allowable

"When, during the examination of a pro se case, it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, he shall draft one or more claims for the applicant and indicate in his action that such claims would be allowed if incorporated in the application by amendment"

"The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction"

408 Telephoning Attorney

"Present Office policy places great emphasis on telephone interviews initiated by the examiner"